

ESTTA Tracking number: **ESTTA426442**

Filing date: **08/22/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054055
Party	Plaintiff FK Republika Srpska, NFP
Correspondence Address	PHILLIP BARENGOLTS PATTISHALL MCAULIFFE NEWBURY HILLIARD ET AL 311 SOUTH WACKER DRIVE, SUITE 5000 CHICAGO, IL 60606 UNITED STATES pb@pattishall.com, dih@pattishall.com, lrb@pattishall.com
Submission	Other Motions/Papers
Filer's Name	Daniel In Hwang
Filer's e-mail	pb@pattishall.com, dih@pattishall.com, sm@pattishall.com
Signature	/Daniel In Hwang/
Date	08/22/2011
Attachments	Cancellation No_92054055 - Reply in Support of Motion to Strike.PDF (5 pages) (42743 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration Nos. 3,823,417 and 3,823,424: FK REPUBLIKA SRPSKA
Registration Date: July 20, 2010

FK REPUBLIKA SRPSKA, NFP,)	
)	
Petitioner,)	Cancellation No. 92054055
)	
v.)	
)	
ATHLETIC FOUNDATION SRPSKA,)	
INC.,)	
)	
Registrant.)	

**PETITIONER'S REPLY IN SUPPORT OF
PETITIONER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES AND
PETITIONER'S RESPONSE TO REGISTRANT'S MOTION FOR LEAVE TO AMEND**

I. Introduction

In response to the motion to strike filed by Petitioner, FK Republika Srpska, NFP ("FRS"), Registrant, Athletic Foundation Srpska, Inc. ("AFS"), sought leave to file and filed an Amended Answer. FRS requests that leave to file the Amended Affirmative Defenses be denied because FRS did not consent to the filing and AFS failed to comply with Rule 15(a) of the Federal Rules of Civil Procedure and Section 507.01 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP").

Furthermore, the facts alleged in the Amended Answer would still be insufficient to plead the affirmative defenses of acquiescence and estoppel. Additionally, AFS's pleading of the new defense of laches fails as a matter of law. Therefore, FRS maintains its motion to strike the affirmative defenses of acquiescence and estoppel from the Answer (or Amended Answer, if the

Board grants AFS leave to file it) and requests that the Board deny AFS leave to file the Amended Answer with respect to the defense of laches.¹

II. Argument

AFS filed its original answer on July 5, 2011. Docket No. 4. Under Fed. R. Civ. P. 15(a), AFS had until July 26, 2011, to amend its answer without leave or consent from FRS. FRS filed its motion to strike on July 25, 2011. AFS never sought FRS's consent to file the Amended Answer and submitted no reasons in its motion for leave for why it should be given leave to amend its answer after its time to do so expired. *See* Fed. R. Civ. P. 15(a)(2). AFS's failure to comply with these requirements is reason enough to deny its motion for leave to amend. Furthermore, all of the defenses asserted in the Amended Answer still fail as a matter of law, as discussed below. *See* TBMP § 507.02 ("where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend"); *see also*, 6 CHARLES ALAN WRIGHT, ARTHUR R. MILLER & MARY KAY KANE, FEDERAL PRACTICE AND PROCEDURE (hereinafter, "WRIGHT & MILLER") § 1487 (3d ed. West 2011) (A proposed amendment that "fails to include allegations to cure defects in the original pleading" should be denied as futile). Thus, the Board should deny AFS's motion for leave to amend and reject AFS's Amended Answer.

A. AFS's Proposed Amended Answer Fails to Adequately Plead Acquiescence

As FRS argued in its Motion to Strike, AFS's defense of acquiescence requires facts at least suggesting that FRS gave AFS express consent, encouragement or permission to use and register the mark FK REPUBLIKA SRPSKA. *Hitachi Metals International v. Yamakyu Chain*

¹ The Amended Answer also does not admit or deny the allegations of the Petition for Cancellation.

Kabushiki, 209 U.S.P.Q. 1057, 1067 (T.T.A.B. 1981); *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 U.S.P.Q.2d 1401, 1409 (11th Cir. 1991) (requiring active representation by party accused of allegedly acquiescing). AFS's proposed allegations that "at no time prior to 2009 did any of [Petitioner's] principals ever object" (Response, Ex. A, ¶5) or that Petitioner's alleged "failure to object" (Response, Ex. A, ¶6) do not allege that FRS gave AFS express permission or actively represented that AFS could use and register the mark FK REPUBLIKA SRPSKA.

B. AFS's Proposed Amended Answer Fails to Adequately Plead Estoppel

Similarly, FRS maintains that AFS's proposed allegations still fail to show "some affirmative act by plaintiff which led defendant to reasonably believe that plaintiff would not oppose defendant's registration of its mark." *National Cable Association, Inc. v. American Cinema Editors, Inc.*, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) (citing insufficient evidence of any affirmative acts by petitioner to reject a defense of estoppel). Neither the Answer or Amended Answer allege any "affirmative acts" by FRS to provide permission to AFS to use and register the mark FK REPUBLIKA SRPSKA.

C. AFS's Defense of Laches Would Fail as A Matter of Law

AFS's attempt to add the affirmative defense of laches is futile. WRIGHT & MILLER § 1487 (3d ed. West 2011) (citing *Vitabiotics, Ltd. v. Krupka*, 606 F. Supp. 779, 786 (E.D.N.Y. 1984) (holding that nothing in the proposed amended answer put forth by defendant would alter court's disposition of summary judgment motion and this futility of the amendment is a proper reason to deny leave to amend)). This defense would fail as a matter of law because the time for laches could not possibly start to run prior to the publication date of AFS's registrations, June 11, 2010, just over a year before this action was filed. *National Cable*, 19 U.S.P.Q.2d. at 1432 (Fed. Cir. 1991) (finding that "often it cannot be known immediately how a junior user will proceed to

develop, display, or even change what it claims as its mark" and accordingly, that "laches, with respect to protesting the issuance of the registration for the mark, could not possibly start to run prior to" the publication date of the relevant application). Having to address AFS's allegations concerning use of the mark while AFS's principal was a member of FRS would increase discovery costs and confuse the issues properly before the Board, to the prejudice of FRS.

III. Conclusion

For the reasons stated above, AFS's affirmative defenses of acquiescence and estoppel continue to be legally insufficient and fail to conform to pleading requirements, even in light of the proposed amendments to the Affirmative Defenses. Accordingly, FRS requests that the Board grant its Motion to Strike them.

Further, for the reasons stated above, AFS's request to include a third affirmative defense of laches would unfairly prejudice FRS, and therefore FRS requests that the Board deny AFS's Motion for Leave to Amend.

Respectfully submitted,

Dated: August 22, 2011

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

By: /Daniel I. Hwang/
Phillip Barengolts
Daniel Hwang
Pattishall, McAuliffe, Newbury,
Hilliard & Geraldson LLP
311 South Wacker Drive, Suite 5000
Chicago, Illinois 60606
(312) 554-8000

Attorneys for FK Republika Srpska, NFP

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **PETITIONER'S REPLY TO REGISTRANT'S RESPONSE TO MOTION TO STRIKE AFFIRMATIVE DEFENSES FROM APPLICANT'S ANSWER AND PETITIONER'S RESPONSE TO REGISTRANT'S MOTION FOR LEAVE TO AMEND** was served by first-class mail on August 22, 2011, postage prepaid, upon the following:

Kenneth S. McLaughlin, Jr.
Esp, Kreuzer, Cores & McLaughlin, LLP
400 S. County Farm Rd.
Suite 200
Wheaton, IL 60187

/Daniel Hwang/